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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/063,108 | 03/21/2002 | Dotan Saguy | 001 010 | 3451 |
| 29569 | 7590 | 12/23/2005 | EXAMINER | |
| JEFFREY FURR 253 N. MAIN STREET JOHNSTOWN, OH 43031 | | | LASTRA, DANIEL | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3622 | |

DATE MAILED: 12/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/063,108

Applicant(s)

SAGUY, DOTAN

Examiner

DANIEL LASTRA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 21-40 have been examined. Application 10/063,108 (DIRECT MARKETING SYSTEM) has a filing date 03/20/2002 Claims Priority from Provisional Application 60277956 03/23/2001.

Response to Amendment

2. In response to Non Final Action filed 06/27/2005, the Applicant filed an Amendment on 10/03/2005, which cancel claims 1-10 and added new claims 21-40.

Claim Objections

3. Claim 33 is objected to because it recites dependency to cancel claim 3. For purpose of art rejection, claim 33 is made dependent of claim 31.

Claim 32 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 32 is dependent of claim 23 and therefore also dependent of claim 22, which recites the same limitation of claim 32. For purpose of art rejection, claim 32 is made dependent of claim 31.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 21-25, 27-35 and 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bansal (US 6,804,806) in view of Ganesan (US 2002/0087427) and further in view of Nelson (US 2002/0042775).

As per claims 21 and 31, Bansal teaches:

A system for sending electronic greetings from multiple users comprising:

having a user register to become a sender (see Bansal column 6, lines 9-35) ;

having said sender select an electronic greeting (see Bansal column 6, lines 11-35);

having said sender select a plurality of Invitees (see Bansal column 6, lines 11-25);

having the system notify the invitees of the electronic greeting by E-mail (see Bansal column 6, lines 25-30, 55-67);

having said Invitees add information to the electronic greeting by clicking said URL address in said E-mail (see Bansal column 6, lines 25-30, 55-67. Bansal teaches of transmitting the starter greeting and greeting options to the contributors and recipient via the Internet and via electronic mail. Official Notice is taken that it is old and well known in the computer art that if a user wants to read or add information to an electronic mail, said user need to click the URL address of said electronic mail. It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Bansal would transmit to contributors an electronic starter greeting and greeting options via email, where said contributors would have to click on the URL address of said email to be able to read and add input to said greeting.

Bansal fails to teach having said sender select a gift; where said sender can make a contribution to said gift; having the system notify the invitees of the gift by E-mail which has an embedded URL address; having said sender apply the contributions towards the purchase of said electronic gift by clicking said URL address in said E-mail; where said sender can change said gift to match the amount of contributions and forwarding said electronic greeting and said gift to a plurality of receivers selected by said sender. However, Ganesan teaches a system that transmits to users electronic greeting messages and gifts, where said gifts are credited to a deposit account associated with a recipient (see paragraphs 48-50). Nelson teaches a system where a gift giver contacts other individuals to initiate a pooling of resources to purchase an item or commodity (see Nelson paragraph 25). Therefore, it would have been obvious to a person of ordinary skill in the art that Bansal would transmit to users an electronic gift (i.e. electronic money) in an electronic greeting message, as taught by Ganesan and would pool resources for all the users that contribute to said electronic greeting to pay for said electronic gift. This feature would allow that all contributors to the electronic greeting would simultaneously provide their input to said greeting and would also allow said contributors to pay for the expenses incurred for sending said electronic gift and greeting.

As per claims 22 and 32, Bansal teaches a system according to claim 23 but fails to teach in which said invitees can select a plurality of invitees. However, Ganesan teaches an electronic greeting and gift card system where members invite other users to join said system (see paragraph 220). Therefore, it would have been obvious to a

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person of ordinary skill in the art at the time the application was made, to know that Bansal would allow members to invite other users to contribute to said electronic greeting system, as taught by Ganesan. This way all the contributors would simultaneously provide their input to the electronic greeting messages.

As per claims 23 and 33, Bansal teaches:

A system according to claim 3 in which said sender can modify the information added by the invitees (see column 6, lines 55-67).

As per claims 24 and 34, Bansal teaches:

A system according to claim 31 in which said notification is through E-mail (see column 6, lines 25-30).

As per claims 25 and 35, Bansal teaches:

A system according to claim 31 in which said system utilizes the Internet (see column 3, lines 7-10; column 6, lines 25-30).

As per claims 27 and 37, Bansal teaches a system according to claim 31 but fails to teach in which said gift is an electronic gift. However, the same argument made in claim 31 regarding this missing limitation is also made in claims 27 and 37.

As per claims 28 and 38, Bansal teaches a system according to claim 31 but fails to teach in which said gift is an electronic cash. However, the same argument made in claim 31 regarding this missing limitation is also made in claims 28 and 38.

As per claims 29 and 39, Bansal teaches:

A system according to claim 31 in which said card and gift is for a specific holiday (see Bansal column 15-22).

As per claims 30 and 40, Bansal teaches:

A system according to claim 31 in which said card and gift is for a specific event (see column 1, lines 15-22).

Claims 26 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bansal (US 6,804,806) in view of Ganesan (US 2002/0087427) and further in view of Nelson (US 2002/0042775) and Lomangino (US 2002/0052756)..

As per claims 26 and 36, Bansal teaches a system according to claim 31 but fails to teach in which said contributions can be made by pledges. However, Lomangino teaches a method of receiving from a second donor member a pledge applicable to the transfer of a particular item and identifying the pledge to an eligible recipient member (see abstract). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Bansal and Ganesan would allow that contributions to gifts be made by pledges, as taught by Lomangino, as said pledges would ensure the payment for said gift.

Response to Arguments

5. Applicant's arguments filed 10/03/2005 have been fully considered but they are not persuasive. The Applicant argues that Bansal does not address the group gift and contribution process of Applicant's invention. The Examiner answers that Ganesan address the group gift and contribution process.

The Applicant argues that the Applicant's process outlined in the application for inviting "signers" and their donations is different and superior to Bansal because according to the Applicant, the Applicant's process maximizes the viral aspect of the

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model through the whole system which does not even come up in other referenced applications. The Applicant further argues that the referenced patents do not come close to the tightly integrated approach of Applicant's groupcards where others get invited to sign and contribute to a group gift. The Examiner answers that the Applicant is making arguments that are not stated or described in the claims.

The Applicant argues that the Applicant's process is far superior in a group gift tied to a group card than which is put forth in the Nelson patent application. The Examiner answers that the Applicant is arguing about features that are not stated in the claims.

The Applicant argues that the Ganesan patent is not a good comparison to the Applicant's invention, since the system is for a single giver to a single giver. The Applicant further argues that the Applicant's process is a much more complex system as it involves multiple givers and receivers and an electronic environment. The Examiner answers that Bansal teaches a system that involves multiple givers and receivers (see Bansal column 6, lines 9-35) and the Examiner used Ganesan to teach the limitation of sending a gift with an electronic greeting.

The Applicant argues that the Lomangino patent application deals with donation exchange and not tying that exchange to an electronic card. The Applicant further argues that Applicant's process of tying contributions from a number of persons is novel and unique and non-obvious over the Lomangino reference. The Examiner answers that the Applicant's claims 26 and 36 teaches the limitation of making contributions with pledges. The Lomangino reference teaches that it is old and well known in the business

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art to make contributions with pledges. Therefore, this cited limitation would not be a patentable distinct feature.

The Applicant argues that the process Applicant has outlined in his claimed invention for inviting signers and their donation is different and superior to the referenced art. The Examiner answers that the Applicant is arguing about features that are not stated in the claims. Even if said argument were claimed, it would not be a patentable distinct feature.

The Applicant's argues that his claimed invention is not obvious based on the extreme marketability of the current invention. The Examiner answers that MPEP 716.03(b) [R-2] "In considering evidence of commercial success, care should be taken to determine that the commercial success alleged is directly derived from the invention claimed, in a marketplace where the consumer is free to choose on the basis of objective principles, and that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention, etc. *In re Mageli*, 470 F.2d 1380, 176 USPQ 305 (CCPA 1973) (conclusory statements or opinions that increased sales were due to the merits of the invention are entitled to little weight); *In re Noznick*, 478 F.2d 1260, 178 USPQ 43 (CCPA 1973). In ex parte proceedings before the Patent and Trademark Office, an applicant must show that the claimed features were responsible for the commercial success of an article if the evidence of nonobviousness is to be accorded substantial weight. See *In re Huang*, 100 F.3d 135, 140, 40 USPQ2d 1685, 1690 (Fed. Cir. 1996) (Inventor's opinion as to the

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purchaser's reason for buying the product is insufficient to demonstrate a nexus between the sales and the claimed invention.). Merely showing that there was commercial success of an article which embodied the invention is not sufficient. Ex parte Remark, 15 USPQ2d 1498, 1502-02 (Bd. Pat. App. & Inter. 1990). Compare Demaco Corp. v. F. Von Langsdorff Licensing Ltd., 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir.1988) (In civil litigation, a patentee does not have to prove that the commercial success is not due to other factors. "A requirement for proof of the negative of all imaginable contributing factors would be unfairly burdensome, and contrary to the ordinary rules of evidence."). See also Pentec, Inc. v. Graphic Controls Corp., 776 F.2d 309, 227 USPQ 766 (Fed. Cir. 1985) (commercial success may have been attributable to extensive advertising and position as a market leader before the introduction of the patented product); In re Fielder, 471 F.2d 690, 176 USPQ 300 (CCPA 1973) (success of invention could be due to recent changes in related technology or consumer demand; here success of claimed voting ballot could be due to the contemporary drive toward greater use of automated data processing techniques); EWP Corp. v. Reliance Universal, Inc., 755 F.2d 898, 225 USPQ 20 (Fed. Cir. 1985) (**evidence of licensing** is a secondary consideration which must be carefully appraised as to its evidentiary value because licensing programs may succeed for reasons unrelated to the unobviousness of the product or process, e.g., license is mutually beneficial or less expensive than defending infringement suits). The Examiner answers that because another company is trying to purchase the Applicant's claimed invention or that the Applicant has licensed

his claimed invention to another company is not sufficient proof that his claimed invention is not obvious from the prior art.

Conclusion

6. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

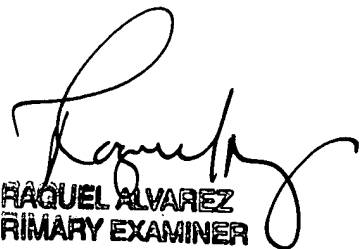
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra
December 10, 2005


RAQUEL ALVAREZ
PRIMARY EXAMINER